

**REMARKS**

**I. Introduction**

The present amendment is filed in response to the Office Action dated June 24, 2004 for the above-identified patent application. Claims 8-16 are pending in the application. Claims 8-16 have been rejected. Claim 9 has been cancelled. Claims 8 and 10-15 have been amended, as discussed below. Claims 17 and 18 have been added. Claim 17 has been added to recite the use of whole *E. coli* cells in contrast to cell extracts and claim 18 has been added to recite the use of a specific NADPH-dependent gene derived from *Sporobomyces salmonicolor*. Support for claim 18 is found at page 7 lines 3-8 and Figure 1.

Support for the amendments and new claims can be found throughout the specification and claims as originally filed. There is no new matter added as a consequence of the amendments or new claims.

Applicants have also amended the specification at page 7 to include the label "Brief Description of Drawings" and at page 1 to recite that this application was filed under 35 U.S.C. 371 as the national phase of PCT/EP99/01017 filed February 18, 1999.

**II. Rejections Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn**

Claims 8-16 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, in the office action it is stated that claim 8 recites "4,4,4-trifluoro" at line 2 and "a trifluoro" at line 12 that appears to be a "4,4,4-trifluoro" compound. However, claim 8 recites "4,4,4-trifluoro-3(R)-hydroxybutyric acid derivatives" at line 2 and "a trifluoroacetoacetic acid derivative of formula II" at line 12. Claim 8 further recites that "the trifluoroacetoacetic

acid derivatives of formula II [lead] to the production of 4,4,4-trifluoro-3(R)-hydroxybutyric acid derivatives.” Consequently, the trifluoro compound at line 12 is not the same 4,4,4,-trifluoro compound recited at line 2. Therefore it is respectfully submitted that Claim 8 is not inconsistent.

It is stated in the office action that claims 8 and 9 confusingly recite “a microorganisms.” It is further stated that claim 11 fails to find proper antecedent basis in claim 9 for “*Escherichia coli*” and that claims 13 and 15 improperly depend on multiple dependent claims. Finally, it is stated in the office action that it is uncertain whether “the process” recited in claims 13 and 14 are of transformation or the bioconversion. In response, Claims 8, 9, 11, and 13-15 have been amended to overcome the rejections. Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of claims 8-16 and 9-10 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is respectfully requested.

### **III Rejections Under 35 U.S.C. § 112, First Paragraph, Should Be Withdrawn**

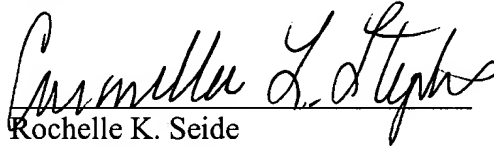
Claims 8-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, it is alleged that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Independent claim 8 has been amended to recite “a microorganism of the species *Escherichia coli*, or cell-free extracts derived therefrom wherein said microorganism is transformed with a gene encoding a NADPH generator or regenerator and wherein said microorganism expresses an NADPH-dependent enzyme having carbonyl reductase activity.” Support for this amendment can be found throughout the specification and, in particular, at pg. 3

lines 28-39; pg. 4 lines 30-35. Applicants submit that claims 8-16, as amended, contain subject matter that complies with the written description requirement. Accordingly, reconsideration and withdrawal of the rejection of claims 8-16 is respectfully requested.

#### IV Conclusion

In view of the foregoing amendments and remarks, reconsideration and allowance is respectfully requested.

Respectfully submitted,



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